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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,129	12/20/2001	Christine J. Landry-Coltrain	83466LMB	2382

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Paul A. Leipold
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER

SCHWARTZ, PAMELA R

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,129

Applicant(s)

LANDRY-COLTRAIN ET AL.

Examiner

Pamela R. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 2,12-17,19-28,43 and 45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-11,18,29-42 and 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-45 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. Applicant's election with traverse of Group I, claims 1-42, 44 and 45, and species 2, claims 3-11, 18 and 44, in Paper No. 5 is acknowledged. The traversal is on the ground(s) that both independent claims claim an inkjet recording element comprising at least two ink receiving layers wherein at least one of the two ink receiving layers comprises porous polyester particles. This is not found persuasive because the article can be used in a materially different method as set forth in Paper No. 3. Consequently, the scope of the search for these two groups of claims is not coextensive and the additional required search would be burdensome.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1, 3-11, 18, 29-42 and 44 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-51 of copending Application No. 10/028,130. Although the conflicting claims are not identical, they are not patentably distinct from each other because the other applicant is directed to an ink jet recording element that has the same porous polyester particles in an ink receiving layer on a support. The support may be porous and ink receiving, and therefore, reads on the lower ink receiving layer of the instant claims. Conventionally, paper supports include inorganic particles, such as those instantly claimed and sizing agents which include some of applicants' instantly recited binders. Surface gloss and layer thicknesses are disclosed by the claims of the copending application (see claims 46 and 48).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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3. Claims 1, 3, 4, and 44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 and 1-9 of U.S. Patent No. 6,528,147 and 6,475,602 respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims recite in ink jet recording element including a support and an image receiving layer comprising porous polymeric particles having a median diameter of less than about 1 micron. The term "polymeric," as recited by these claims, includes polyester. Therefore, the inclusion of porous polyester particles of less than 1 micron would have been obvious from these claims.

4. Claims 1, 3-11, 18, 29-42 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al. (Japanese Kokai Patent Application No. Hei 7[1995]-137432). The reference discloses an ink jet recording paper having an ink absorbing layer coated on a support the ink absorbing layer (the top most layer) containing porous polyester resin particles ([0005] - indicates appropriate paragraph of prior art translation supplied by applicants). The volume average particle diameter is 0.50100 microns. The examiner cannot patentably distinguish 0.5 microns from less than 0.5 micrometers in the absence of a showing of the criticality of this feature. The examiner has considered applicants' showings but was unable to identify showings that demonstrated the criticality of particle size by varying only this feature of the recording medium [0006]. The support, which is an ink receiving layer, may include inorganic or organic fillers and sizing agents [0025]. The reference discloses that sizing agents include polyvinyl alcohol, but is silent with respect to inorganic and organic fillers [0003]. However, these

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filler particles are conventional in the art. The reference discloses use of underlayers or specialty supports in order to obtain a smooth surface. Normally, smoothness and gloss are related characteristics. It is also well known in the art to form or treat the ink receiving layer in a way that maximizes gloss when a glossy surface is desired. For example, it is well known to calendar the surface of the medium to increase gloss. It would have been obvious to one of ordinary skill in the art to treat the surface of the medium of the reference in order to obtain a desired level of gloss.

The reference discloses the formation characteristics of the polyester particles in paragraphs [0008]-[0013] including the use of fumaric or maleic acid in forming the polyester, inclusion of sulfonated monomers, number average molecular weight of the polyester, and the content of ionic groups. The acid content is not described in terms of an acid number, but the reference does disclose mole % of acid and it would have been obvious to determine the acid number using this information. The particles may be in a binder including polyvinyl alcohol and other known binders [0023] and may be used in the instantly claimed proportions [0024]. Divinylbenzene may be used as a monomer to crosslink the polyester resin of the reference [0013]. Layer thicknesses are disclosed [0024] and it is also obvious to one of ordinary skill in this art to determine layer thicknesses and thickness of the medium overall in order to obtain necessary levels of ink absorption and required levels of machine feedability and handling characteristics of the media.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela R. Schwartz whose telephone number is 703-

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308-2424 ((571) 272-1528 as of 12/31/03). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on (703) 308-0449 ((571) 272-1526 as of 12/31/03). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

PRSchwartz
November 17, 2003



PAMELA R. SCHWARTZ
PRIMARY EXAMINER